

## **REMARKS**

Receipt of the Office Action of September 13, 2005 is gratefully acknowledged.

Claims 12 and 14 - 23 were included in the remand by the Board of Appeals for further consideration, namely: (1) "....whether the examiner has modified his theory of unpatentability in the answer...."; and (2) "....whether the submission accompanying appellant's brief on appeal have been entered and considered...".

The present Office Action addressed (1) but not (2).

**Regarding (1)**, the examiner resurrects two of her initial rejects (which were not on appeal) and introduces a new rejection. The rejection that was appealed has been withdrawn. The rejections are: claims 12, 14 - 16, 22 and 23 as anticipated by Bosko under 35 USC 102(b); claim 17 as unpatentable under 35 USC 103(a) over Bosko in view of Coallier (newly cited); and claims 18 - 21 as unpatentable under 35 USC 103(a) over Bosko in view of Jackson.

In discussing Bosko, the examiner states that col. 1, lines 40 - 45 supports the claimed feature that the training apparatus serves to massage the palms and promotes body bearing and motion. Applicant cannot agree. The referenced passage states:

the receptacles are molded and/or fabricated of pliable strong rubber or plastic materials, transparent or opaque, as desired, and of any color. Rubber, plastic or suitable balls of a dumbbell, or barbell may be of any practical size and of any convenient shape which would become advisable for all practical reasons ....

Where is there even a hint that massaging the palms can be effected, or that body bearing and motion can be promoted? It simply is not there. Next the examiner states that col. 1, lines 35 - 50 supports the claimed feature that the end elements each have a spherical region the diameter of which is adapted to the palm of the hand of a training person. Applicant cannot agree. The referenced passage, in addition to what is noted above, also states:

Some containers may require a gallon of water, so

are made approximately 7.6 inches in internal diameter to provide 231 cubic inches whereby 8 pounds of water can be retained therein. For certain reasons the containers are reinforced to hold greater quantities of material, say 5 gallons of water, if the occasion should arise

Where is there even a hint that the diameter of the end elements are adapted to the size of the palm of the hand . it simply is not there.

For anticipation to lie, *all* claimed limitations must be disclosed in a single reference, *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). *Bond* instructs us to look for *identity* in the limitations disclosed in the reference to those of the claim. Identity does not, it is respectfully submitted, exist with Bosko and the claimed invention here. The examiner concluded as much after the RESPONSE filed on August 23, 2000, after which the rejection under 35 USC 102 involving Bosko was withdrawn, as it should be here.

In discussing Coalier, the examiner refers to his teaching of the dimension of the radius of the spherical surfaces and nothing else. Coalier does not disclose that the spherical end elements can have a diameter adapted to the palm of the hand. Accordingly, the combination of Bosko and Coalier is no better than Bosko alone since neither teaches the necessary limitation. A similar conclusion is reached when considering Bosko in combination with Jackson.

The examiner should not be intimidated by the apparent simplicity of the invention. It is anything but simple as attested to by the declarations that have been filed . See the discussion below.


**Regarding (2)**, the examiner has failed to implement the direction given by the Board to consider "whether the submissions accompanying appellant's brief on appeal have been entered and considered." These submissions, both data and declarations of third parties must be given their due weight. See, *In re Sernaker*, 217 USPQ 1 (Fed. Cir. 1983). In an ex parte proceeding, as we have here, there can be no basis for ignoring extrinsic evidence, and especially extrinsic evidence which is dispositive of the examiner's rejections. One could not know from looking at the inventive training apparatus that the benefits to be derived are possible, and when a third party employs

the inventive training apparatus and can attest to its benefits, that testimony **must** not be dismissed out-of-hand. Applicant has been requesting consideration of the extrinsic evidence presented well before the examiner's final rejection, and still it has not been considered.

The examiner should consider this evidence, and if a rejection(s) is(are) still made, then these rejections should not be final, since the evidence has been before the examiner since before the appeal was taken.

If the evidence is properly considered, applicant believes that the examiner will agree and find claims 12 and 14 - 23 allowable.

Respectfully submitted,



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